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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Craig Paulsen

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2536

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08/08/2008

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/964,962	<b>Applicant(s)</b> PAULSEN ET AL.	
	<b>Examiner</b> M. Sager	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the remote device (claims 32, 37, 44 and 77), the communication device (claim 37) and the indicia is selected based upon an amount of value received (claims 54-56 and 85) must be shown or the feature(s) canceled from the claim(s). The interview summary notes agreement that remote device and communication device were enabled at least by paragraph 23. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Double Patenting***

2. Applicant is advised that should claim 56 be found allowable, claim 61 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that Applicant had possession of claimed invention at time of filing regarding removed from the flexible display at a later time' as claimed in amendment received July 14, 2006, at least since there is no such removal disclosed. The citation proffered by Applicant's remarks of steps 100, 102, 108 and 110 as best understood pertain to display of outcome indicia at end of prior game and selection of indicia for a next/current game play; however, there is no teaching or suggestion that first indicia is removed. Agreeably, the selected indicia in a current game may replace the image of symbol(s) in viewing window of prior game

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outcome based on randomly determined outcome; however, removed from the flexible display as claimed suggests the symbol is no longer present on the reel strip and this is not disclosed, suggested and also is not inferred or inherent at least since this seems to imply a reprogramming of symbols on the reel strip in the game as the game is played.

5. Claims 54-56 and 85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that Applicant had possession of claimed invention at time of filing regarding an amount of value received at the gaming apparatus as claimed in amendment received Feb 3, 2006. There is no suggestion or teaching, implied or inherent that reasonably conveys a gaming apparatus selects indicium based upon an amount of value received such that there is a correspondence or stated differently that there is a correspondence in indicia selected based on an amount wagered. As disclosed, an amount of value received at a gaming apparatus is either an amount inserted into gaming apparatus or an amount wagered (step 104, 106) that allows the gaming apparatus to determine the outcome of game play indicium (step 108) and to display the selected game play indicium (step 110), but an amount of value received such as funds input or amount wagered does not alter or effect the indicium selected as claimed.

6. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. Where the [paraphrased] claimed 'displaying the indicium', 'storing programming instruction or information for generating the game play indicia including the indicium' and 'select from a plurality of game play indicium the indicium to display' (or similar language) includes displaying an infinite number of indicium or selection from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicium or storing instructions or information for generating the game play indicia including the indicium so as to generate a list of infinite number of symbols to select the indicia, the original filed specification does not enable the claimed invention with respect to displaying an infinite number of indicium or display indicium selected from an infinite number of symbols' or 'storing instructions or information for generating the game play indicia' that is generating from an infinite number of indicia. To clarify so as to be clear, the issue is with respect to an infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or information to generate the game play indicia from an infinite number of indicia and/or selection from an infinite number of indicium for display (again, memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicium for selection). The original specification (especially paragraphs 18 and 26), as best understood, appears to require either displaying an infinite number of display symbols (indicia) or selecting from a infinite number of symbols to display selected symbol(s); however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium

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where it is generating a list of an infinite number of symbols or selection from an infinite number of symbols is not enabled. The only disclosed value for a plurality of symbols in the original filed specification is infinite (abstract, paragraph 18, 26); however, there is no value for infinite.

7. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that Applicant had possession of claimed invention at time of filing regarding 'displaying the indicium', 'storing programming instruction or information for generating the game play indicia including the indicium' and 'select from a plurality of game play indicia' being selection from an infinite number of symbols' (or similar language) includes displaying an infinite number of indicium or selection from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicium or storing instructions or information for generating the game play indicia including the indicium so as to generate a list of infinite number of symbols to select the indicia, the original filed specification does not enable the claimed invention with respect to displaying an infinite number of indicium or display indicium selected from an infinite number of symbols' or 'storing instructions or information for generating the game play indicia' that is generating from an infinite number of indicia. The only disclosed value for a plurality of symbols in Applicant's original filed specification is infinite (abstract, paragraph 18, 26); however, there is no such obtainable value. To clarify so as to be clear, the issue is with respect to the written specification fails to

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reasonably convey to an artisan that the Applicant possessed the invention regarding an infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or information to generate the game play indicia from an infinite number of indicia and/or select from a plurality of indicia the indicium to display where the plurality is an infinite number of indicia for display (memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicia for selection). The original specification (abstract and paragraphs 18 and 26), as best understood, appears to require either displaying an infinite number of display symbols (indicia) or storing instruction for generating the game play indicia including the indicium that is to select from a plurality of indicia where the plurality of indicia is an infinite number of indicia; however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium where it is generating a list of an infinite number of symbols or selection from an infinite number of symbols is not demonstrated as being possessed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 27-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The cited claims are indefinite since it is unclear how an infinite number of indicia are displayed or how indicium are selected from an infinite number of indicia or how the gaming



apparatus stores an infinite number of indicium for selection at least since the display, memory and controller are finite in capability.

Claim 62 recites the limitation "the theme" in line 1; however, it is noted that claim 61 does not match the function of analogous claims 57 and 59. There is insufficient antecedent basis for this limitation in the claim.

Claim 72 recites the limitation "the flexible display" in line 24 and lacks antecedent basis or is indefinite due to being unclear whether the flexible display is another display.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 27-86 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714